

Appln. No.: 10/047,553  
Amendment Dated August 18, 2006  
Reply to Office Action of May 18, 2006

MATP-616US

**Remarks/Arguments:**

Claims 1-14 are pending in the above-identified application.

Claim 13 was objected to for informalities. These informalities have been corrected.

Claim 1 was rejected under 35 U.S.C. § 102 (e) as being anticipated by Asada et al. This rejection is respectfully traversed. The rejection based on Asada is improper because Asada is not a prior art reference against this application. The present application was filed on October 26, 2001. Asada has a U.S. filing date of January 30, 2002. Thus, Asada et al. is not prior art under 35 U.S.C. § 102 (e). Because Asada et al. cannot be used as a prior art reference, claim 1 is rejected under 35 U.S.C. § 102 (e) as being anticipated by Asada et al.

Claims 5-7 were rejected under 35 U.S.C. § 102 (b) as being anticipated by Metz et al. Applicants respectfully request reconsideration of this rejection. In particular, Metz et al. do not disclose or suggest

a card information structure (CIS) for identifying the smart card as a code upgrade card **while the host device is operating**. (Emphasis added)  
as required by claim 5.

Basis for this amendment may be found in the specification at paragraphs [0043] and [0045]. With regard to claim 1, Metz et al. do not disclose or suggest a smart card having a memory which includes "...a card information structure (CIS) for identifying the smart card as a code upgrade card **while the host device is operating**." As described in Metz at column 23, lines 14-23, the "bit pattern" on the PCMCIA card can be read only during system initialization. The "bit pattern" structure defined in Metz that is read by the digital entertainment terminal (DET) is not equivalent to the card information structure (CIS) required by claim 5. As described in the specification of the application, however, the CIS may be read anytime the card is inserted into the set-top box. (Specification, paras 0043-0047). These paragraphs indicate that certain tests may be performed on the upgrade card after the host device recognizes the upgrade card and before the bootstrap loader is invoked. For example, the present invention may check to see if the upgrade is compatible with the host device. The prior art, because it emulates a floppy disk, invokes the bootstrap loader without these tests. (Col. 23, lines 6-14). In other words, the host device in the prior art boots off of the PCMCIA card and thus, cannot

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check for compatibility. Because these tests are performed, the subject invention recognizes the card as a card upgrade "while the host device is operating." This provides the subject invention with an advantage as the card may be used when the set-top box is operating.

Further, CIS is well known. The bit pattern in Metz et al. cannot be a CIS because the broadcast service providers would need to be aware of the CIS. The broadcast service providers in Metz et al. however, are not aware of the bit pattern. (Col. 23, lines 25-29).

Because Metz et al. do not disclose or suggest this limitation of claim 5, claim 5 is not subject to rejection under 35 U.S.C. § 102(b) in view of Metz et al. Claims 6-7 depend from claim 5. Accordingly, claims 6-7 are not subject to rejection under 35 U.S.C. § 102(b) in view of Metz et al.

Claims 2, 3 and 8 were rejected under 35 U.S.C. § 103 (a) as being obvious in view of Asada et al. and Metz et al. As described above, Asada et al. cannot be used as a prior art reference against this application. Because Asada et al. is not prior art, claims 2, 3 and 8 are not subject to rejection under 35 U.S.C. § 103(a) in view of Asada et al. and Metz et al.

Claims 9-13 were rejected under 35 U.S.C. § 103 (a) as being obvious in view of Asada et al. and McClellan et al. As described above, Asada et al. cannot be used as a prior art reference against this application. Because Asada et al. is not prior art, claims 9-13 are not subject to rejection under 35 U.S.C. § 103(a) in view of Asada et al. and McClellan et al.

Claim 4 was rejected under 35 U.S.C. § 103 (a) as being obvious in view of Asada et al., Metz et al. and Kidder et al. As described above, Asada et al. cannot be used as a prior art reference against this application. Because Asada et al. is not prior art, claim 4 is not subject to rejection under 35 U.S.C. § 103(a) in view of Asada et al., Metz et al. and Kidder et al.

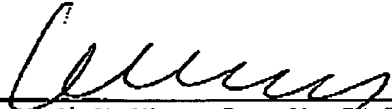
Claim 14 was rejected under 35 U.S.C. § 103 (a) as being obvious in view of McClellan et al., Asada et al. and Kidder et al. As described above, Asada et al. cannot be used as a prior art reference against this application. Because Asada et al. is not prior art, claim 14 is not subject to rejection under 35 U.S.C. § 103(a) in view of McClellan et al., Asada et al. and Kidder et al.

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In view of the foregoing amendments and remarks, Applicants request that the Examiner reconsider and withdraw the objections to claim 13 and the rejection of claims 1-14.

Respectfully submitted,

  
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